

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 29, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Randall Products International, Inc.

Serial No. 74/674,920

George J. Netter, Esq. for applicant.

Geoffrey McNutt, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Hanak, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Randall Products International, Inc. has filed a
trademark application to register the mark SPA CARIBBEAN
for "shampoo, conditioner, body lotion, bath and shower

Serial No. 74/674,920

gel, and sun block."¹ The application includes a disclaimer of CARIBBEAN apart from the mark as a whole.²

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark shown below, previously registered for "health spa services, namely, sauna, body massage and body waxing services, hair and nail salon services, skin care and facial treatment services," and "health club services and exercise and fitness facilities,"³ that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive. The cited registration includes a disclaimer of CARIBBEAN SPA apart from the mark as a whole.

¹ Serial No. 74/674,920, in International Class 3, filed May 17, 1995, based on use of the mark in commerce, alleging first use and first use in commerce as of November 17, 1993.

² Applicant initially offered a disclaimer of SPA in response to a requirement by the Examining Attorney. The Examining Attorney then indicated that a disclaimer of SPA was unnecessary and that the disclaimer of SPA would not be printed. He required, instead, a disclaimer of CARIBBEAN. Applicant complied by submitting the required disclaimer. By these actions of the Examining Attorney and applicant we consider the disclaimer of SPA to be revoked.

³ Registration No. 1,637,166 issued March 5, 1991, to Pier House Joint Venture, in International Classes 42 and 41, respectively. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

In the analysis of likelihood of confusion in this case, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Regarding the marks, the Examining Attorney contends that the word portion of registrant's mark is the dominant portion of that mark; that applicant's mark is essentially a transposition of the dominant word elements of registrant's mark; and that this transposition does not alter the commercial impression of the mark, thus, the commercial impression of applicant's mark is substantially the same as that of registrant's mark.

Applicant contends, on the other hand, that the disclaimer of the words CARIBBEAN SPA in the cited registration establishes that the words are not the dominant or most significant feature of the registered mark. Applicant argues, further, that, even if one considers only the word portion, CARIBBEAN SPA, of

registrant's mark, the reversal of those words in applicant's mark, SPA CARIBBEAN, creates a totally different commercial impression from the registered mark. Applicant states that the initial word in each mark gives the respective marks "a different appearance and accordingly applicant's mark emphasizes 'SPA' over 'CARIBBEAN' whereas the registration's emphasis is on 'CARIBBEAN' rather than 'SPA.'" "

The proper test for determining the issue of likelihood of confusion is the similarity of the general commercial impression engendered by the marks. Due to the consuming public's fallibility of memory, the emphasis is on the recollection of the average customer, who normally retains a general rather than a specific impression of trademarks or service marks. *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd*. No. 92-1086 (Fed. Cir. June 5, 1992); and *In re Steury Corporation*, 189 USPQ 353 (TTAB 1975). Both applicant and the Examining Attorney recognize the well established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, while the marks are compared in their entireties, including descriptive or disclaimed portions thereof, "there is nothing improper in stating that, for rational reasons,

Serial No. 74/674,920

more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). If a mark comprises both words and a design, the words are normally accorded greater weight because the words are likely to make an impression upon purchasers that would be remembered by them and would be used by purchasers to request the goods and/or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also: *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

The cited registration in the case before us is a compound mark consisting of the words, "Caribbean Spa" in a stylized print with a design of a beach scene and palm tree. The wording, "Caribbean Spa," is disclaimed. Clearly, in connection with the issue of descriptiveness, registrant's disclaimer is an admission that, at the time of registration, the phrase "Caribbean Spa" was merely descriptive in connection with the services identified in the registration. However, as the wording of the disclaimer indicates (i.e., "no claim is made to the

exclusive use of "Caribbean Spa" *apart from the mark as shown* - *emphasis added*), the phrase "Caribbean Spa" is accorded significance as an integral part of the composite mark. *See, American Dietetics Company, Inc. et. al. v. Plus Products*, 191 USPQ 146 (DCNY 1976). The disclaimer of this phrase in the composite mark does not have the effect of removing the phrase from the mark. *Bordon, Inc. v. W.R. Grace & Co.*, 180 USPQ 157 (TTAB 1973). It is well established that a disclaimer is of no legal significance in determining likelihood of confusion, rather, the disclaimed matter must be considered. *See, Kellogg Co. v. Pack "Em Enterprises Inc.*, 14 USPQ 2d 1545 (TTAB 1990); and *Glamorene Products Corporation v. Boyle-Midway, Inc., et. al.*, 188 USPQ 145 (DCSDNY 1975).

As in the case before us, in the case of *In re National Data Corp.*, *supra*, the mark in the cited registration, CASH MANAGEMENT ACCOUNT, contained a disclaimer, in that case of CASH MANAGEMENT. Following the Office's refusal on the ground of likelihood of confusion, applicant disclaimed CASH MANAGEMENT in its mark, THE CASH MANAGEMENT EXCHANGE, presented evidence purported to show the descriptive character of the phrase "cash management" in connection with financial services, and argued that there was no likelihood of confusion because the only

similarity between the two marks was the descriptive or generic words CASH MANAGEMENT. In rejecting this argument and affirming the Board's finding of likelihood of confusion, our primary reviewing court stated:

The technicality of a disclaimer in National's application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during prosecution of the trademark application at the PTO.

...

The power of the PTO to accept or require disclaimers is discretionary under the statute, ... and its practice over the years has been far from consistent. Thus, it is inappropriate to give the presence or absence of a disclaimer any legal significance.

Id. at 751. (Footnotes omitted.)

Turning to consider the marks in the case before us, we note that, in addition to the words CARIBBEAN SPA, the design element of registrant's mark, which includes a design of a beach scene with a palm tree, is also highly evocative of the Caribbean and, thus, tends principally to reinforce the word portion of the mark. Thus, in considering the commercial impression of registrant's mark, we find the stylized words to be the dominant portion of the mark. Although there is no evidence in the record on this point, when viewed in its entirety, we believe that registrant's mark is at least suggestive in connection with the identified services. However, even suggestive marks

are entitled to protection, albeit a narrower scope of protection than a completely arbitrary mark.

As applicant acknowledges, its mark, SPA CARIBBEAN, is a transposition of the word portion of registrant's mark. We find that, regardless of whether the phrase appears as SPA CARIBBEAN or CARIBBEAN SPA, the connotation remains the same, *i.e.*, both phrases evoke a Caribbean style of spa. While applicant claims that the transposed phrase creates an entirely different meaning, applicant has given us no credible argument or evidence in support of this statement. We find the overall commercial impressions of applicant's mark and registrant's mark to be substantially similar. Thus, if used or registered in connection with the same, similar or related goods and/or services, prospective customers are likely to be confused as to the source of the goods and/or services.

Turning to applicant's goods and registrant's services, the Examining Attorney contends that "it is not uncommon for the same businesses that provide health and beauty services such as the registrant's to also sell cosmetic and beauty products, and to use the same mark to identify themselves as the source of both the goods and the services." The Examining Attorney submitted copies of third-party registrations wherein a single mark is

registered in connection with both goods and services of the types identified herein.⁴

Applicant contends that there is absolutely no relationship between applicant's "cosmetic products" and "registrant's Class 41 services relating to body building or the like."⁵ Applicant characterizes registrant's Class 42 services as "beauty services" that "relate to facilities." Applicant submitted copies of telephone book advertisements under the headings "beauty salons" and "beauty services" that include references to cosmetic products available in connection with the advertised services.⁶ Applicant notes that the products are referred to by names that differ from the name of the facility offering the services.

⁴ A number of the applications and registrations submitted by the Examining Attorney are for goods or services, but not both, or are intent-to-use applications. These submissions are of little probative value because they do not indicate that consumers may be used to seeing the identified goods and services emanating from a single source under the same mark. However, we find in the Examining Attorney's submission a sufficient number of use-based registrations, which include both goods and services of the types identified herein, to be persuasive of the Examining Attorney's contentions.

⁵ We find applicant's attempt to distinguish registrant's Class 41 health club, fitness and exercise services from applicant's goods by characterizing them as "body building or the like" to be disingenuous.

⁶ Several advertisements were submitted with applicant's brief. Ordinarily matter submitted with a brief is untimely and not considered. However, as it is primarily duplicative of the evidence submitted earlier by applicant and the Examining Attorney considered the evidence in his brief, we have considered this evidence herein.

We find sufficient evidence in the record to conclude that goods of the type identified in the application are likely to be sold in connection with the rendering of the services identified in the cited registration. The evidence submitted by applicant supports this conclusion even though it shows such goods identified by marks other than the marks used in connection with the services. The evidence submitted by the Examining Attorney supports this conclusion as well as the further conclusion that such goods and services may be offered under the same mark. Applicant's evidence does not contradict this conclusion.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, SPA CARIBBEAN, and registrant's mark, CARIBBEAN SPA and design, their contemporaneous use on the related goods and services involved in this case is likely to cause confusion as to the source or sponsorship of such goods and services.

Finally, to the extent that we may have any doubt concerning our conclusion that confusion is likely, we are obligated to resolve such doubt in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988). It is well established that one who adopts a mark similar to the mark of another for the same

Serial No. 74/674,920

or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant. *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

Decision: The refusal under Section 2(d) of the Act is affirmed.

T. J. Quinn

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board